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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/630,777 | 08/02/2000 | Tetsuro Kawahara | Q60204 | 8005 |

7590 09/24/2002

Sughrue Mion Zinn MacPeak & Seas PLLC
2100 Pennsylvania Avenue NW
Washington, DC 20037

EXAMINER

FERGUSON, LAWRENCE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

10

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,777

Applicant(s)

KAWAHARA ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage _____ application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Petition to Withdraw the finality of Office Action

1. In response to the petition to withdraw the finality of the previous office action mailed June 6, 2002, Examiner has withdrawn the Finality of the office action and has deemed the office action of paper number eight, NON-FINAL.

Response to Amendment

2. This action is in response to the request for reconsideration mailed August 30, 2002. Claim 3 was canceled and claim 1 was amended rendering claims 1-2 and 4-9 pending.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue, et al. EP 0 901 991 A2.

5. EP '991 discloses a photocatalytic glass pane high in photocatalytic activity with at least one layer formed on at least one major surface of the glass substrate and at least one layer has an outer layer made of photocatalytic titanium oxide (paragraph 0005 through 0007). EP '991 discloses at least one first interlayer and at least one second interlayer made of aluminum oxide, tin oxide or zinc oxide (paragraph 0015, lines 1-5). EP '991 discloses the titanium oxide layer directly formed on a glass substrate (paragraph 0018, line 17). EP '991 discloses the titanium oxide film with a thickness of 135nm (paragraph 0019, line 43) and the aluminum oxide film having a thickness of about 70nm (paragraph 0026, line 55). EP '991 discloses a titanium oxide film formed on the aluminum oxide film (paragraph 0027, line 58). Although EP '991 does not explicitly disclose the films as n-type semiconductor films, they both include semiconductor materials comprising solid crystalline material having electrical conductivity greater than insulators but less than good conductors, such as titanium and aluminum. EP '991 does not disclose an energy band gap. Even though Inoue is silent towards energy band gaps, the claimed band gaps are directly related to the specific semiconductor films used. Since the reference uses the same titanium dioxide and aluminum film as the photocatalyst and primer films, respectively, the energy band gap of these films would be expected to be the same as applicant's claims. Since the films are arranged in the same manner as applicant claims to make an article having

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photocatalytic activity as applicant claims, any other features afforded would be expected to occur, absent a showing of unexpected results.

Claim Rejections – 35 USC § 103(a)

6. Claim 7-9 are rejected under 35 U.S.C. 103(a) as being obvious over Inoue, et al. EP 0 901 991 A2 in view of XP 002151982 and EP 08 20 967 A1.

7. EP 0 901 991 A2 is relied upon for claims 1-6. Inoue, EP '991, does not disclose an alkali diffusion preventive film.

XP '982 teaches an alkali barrier film and a photocatalyst film on a glass substrate. All of the cited references are analogous art because they are from the same field of photocatalytic films. It would have been obvious to one of ordinary skill in the art include the alkali barrier layer interposed between the glass pane and first interlayer of EP '991 to prevent contamination of photocatalytic film so the photocatalytic activity would not be affected.

None of the above references teach a hydrophilic film. EP '967 teaches a glass substrate with a film of a photocatalyzer such as TiO₂ (abstract) and a hydrophilic film (abstract and page 2, lines 48-55). All of the references are analogous art because they are from the same field of photocatalytic films. It would have been obvious to one of ordinary skill in the art to include the hydrophilic film in the on the photocatalyst film of EP '991 to cut down fogging of the films.

Response to Arguments

8. The finality of the previous office action mailed June 6, 2002 has been withdrawn based on Applicant's petition to withdraw the finality of the office action. This is due to using the same art with a different argument within the rejection.

The rejections under 35 USC 103(a) as being obvious over Inoue et al EP 0 901 991 A2 has been considered but is unpersuasive. Applicant argues it is completely unexpected from Inoue that an n-type semiconductor film primer layer consisting essentially of at least one of niobium oxide, tin oxide, and zirconium oxide would result in higher photocatalytic activity of the photocatalyst film and hence, better antifouling properties. Although Applicant states the claimed invention has unexpected results from the Inoue, there is no evidence to support Applicant's position in the form of experimentation and/or declaration.

The rejections under 35 USC 103(a) as being obvious over Inoue et al EP 0 901 991 A2 in view of XP 002151982 and EP 08 20 967 A1 has been considered but is unpersuasive. Applicant argues it is completely unexpected from Inoue that an n-type semiconductor film primer layer consisting essentially of at least one of niobium oxide, tin oxide, and zirconium oxide would result in higher photocatalytic activity of the photocatalyst film and hence, better antifouling properties. Although Applicant states the claimed invention has unexpected results from the Inoue, there is no evidence to support Applicant's position in the form of experimentation and/or declaration.

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Additionally, Applicant canceled claim 3 and incorporated it into independent claim 1.

Although Applicant furthered narrowed the independent claim, the incorporated claim limitation was previously rejected in the office action mailed on June 6, 2002.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

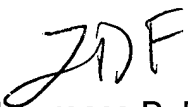
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

